Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)
Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

OIPE
NOV 07 2005
PATENT & TRADEMARK OFFICE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): S850:36530

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on November 3, 2005

Signature: [signature]

Typed or printed name: Lindsey Lin

Application Number	Filed
09/690,243	October 17, 2000

First Named Inventor: Ari Engelberg

Art Unit	Examiner
3621	Firmin Backer

Applicant requests review of the rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [X] attorney or agent of record. Registration number 48,534
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

[signature]
Signature

Jonathan S. Miller
Typed or printed name

626-795-9900
Telephone number

November 3, 2005
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [ ] *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on November 3, 2005.

Lindsey Lin

Appl No. : 09/690,243 Confirmation No. 2962
Applicant : Ari Engelberg, et al.
Filed : October 17, 2000
Title : METHOD AND APPARATUS FOR ON-LINE VALUE-BEARING ITEM SYSTEM

TC/A.U. : 3621
Examiner : Firmin Backer

Docket No. : 36530/SAH/S850
Customer No. : 23363

ARGUMENTS IN SUPPORT OF THE PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Post Office Box 7068
Pasadena, CA 91109-7068
November 3, 2005

Commissioner:

In support of the Pre-Appeal Brief Request for Review submitted herewith, the Applicant requests review for the following reasons:

I. The Examiner has committed a clear error in failing to establish that the cited references, U.S. Patent number 6,005,945 issued to Whitehouse ("Whitehouse") in view of U.S. Patent Application publication number 2005/0114712 by Devine et al ("Devine") teach or suggest each of the elements of the claims.

II. The Examiner has committed a clear error in failing to establish a motivation to combine Whitehouse and Devine.

ARGUMENTS

I. Failure to Teach or Suggest each of the Elements of the Claims

The Examiner has rejected claims 1-79 as obvious over Whitehouse in view Devine under 35 U.S.C. § 103.

To establish a *prima facie* case of obviousness, the Patent Office must show that the cited references teach or suggest each of the elements of a claim. With regard to independent claim 1, this claim includes the elements of "a stateless cryptographic module for authenticating the one or more users" and "wherein each security device transaction data can be processed in the server system in a stateless manner." Similarly, independent claim 39 includes the elements of "wherein each security device transaction data can be processed in the server system in a stateless manner." The Examiner cites the same sections of Devine as teaching this element of claim 39 as relied upon for teaching a stateless cryptographic module in claim 1.

The Examiner admits that Whitehouse does not teach these elements of the claim. Rather, the Examiner relies on Devine for teaching these elements. The Applicant has reviewed the cited sections of Devine but has been unable to discern any part therein that teaches or suggests these elements of the claims. Rather, the cited sections of Devine disclose that the Internet and HTTPS are stateless. See the Abstract and paragraph 140 of Devine. Thus, the Examiner has failed to establish that Devine

teaches or suggests a "stateless cryptographic module" or "wherein each security device transaction data can be processed in the server system in a stateless manner."

Further, claim 39 includes the elements of a "scalable cryptographic module." The Examiner has failed to even allege that either of the cited references teach or suggest this element of claim 39. Thus, Applicants believe the Examiner has made a clear error and request that the obviousness rejection of claims 1-72 be reviewed.

II. Improper Combination of References

To combine the disclosure of two references the Patent Office must establish that the references suggest the desirability of the claimed invention. See MPEP § 2143.01. The Examiner in Paper number 8, argues that one of ordinary skill in the art would have been motivated to modify Whitehouse "to include Devine et al's a stateless (*sic*) cryptographic module for authenticating the one or more users because this would have enhance (*sic*) the security of the system." As discussed above, Devine does not teach or suggest a stateless cryptographic module. Rather, Devine discloses the use of a stateless communication link in the form of the Internet or the use of the HTTPS protocol. The Examiner does not set forth any explanation of how the use of a stateless communication protocol enhances the security of the system of Whitehouse. Whitehouse discloses a system that is already designed to be secure and "securely transmits the generated digital postage indicium to the requesting end user." See Abstract of Whitehouse. Thus, one of

ordinary skill in the art would not think to combine the communication protocol of Devine with the system of Whitehouse as it provides no advantage to that system. Therefore, the Examiner has failed to establish any motivation to combine Devine with Whitehouse. Accordingly, Applicants believe the Examiner has made a clear error and request that the obviousness rejection of claims 1-72 be reviewed.

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

By _____
Jonathan S. Miller
Reg. No. 48,534
626/795-9900

JSM/lal
LAL PAS646697.1-*-11/3/05 9:08 AM